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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91200832
Party	Defendant Honda Giken Kogyo Kabushiki Kaisha (Honda Motor Co., Ltd.)
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BRIGGS & STRATTON CORPORATION and KOHLER CO.,	)	
Opposers,	)	Opposition No. 91200832 (parent)
v.	)	Opposition No. 91200146
HONDA GIKEN KOGYO KABUSHIKI KAISHA,	)	Application Serial No. 78924545
Applicant.	)	

REPLY IN SUPPORT OF APPLICANT'S MOTION TO STRIKE IMPROPER EXPERT TESTIMONY OF FACT WITNESS JEFF WHITMORE

[PUBLIC REDACTED VERSION]

I. Introduction

Opposers' arguments in response to Honda's Motion to Strike are irrelevant to the central issue underlying Honda's objection to the undisclosed opinion testimony of Mr. Whitmore – Opposers' failure to comply with their disclosure obligations under Federal Rule of Civil Procedure 26(a)(2), 37 C.F.R. § 2.120(a)(2), and the Scheduling Order entered by the Board in this proceeding. Opposers do not deny that they failed to disclose their intent to elicit opinion testimony from Mr. Whitmore at any time during this proceeding. Opposers also do not deny that they were aware of this obligation – nor could they, given that they did make such a disclosure for other employee witnesses from whom they contemplated offering such testimony. Instead, Opposers seek to avoid their non-compliance with the rules on the grounds that: 1) Mr. Whitmore is an engineer; 2) he has personal knowledge of the development of the Briggs & Stratton 550 Series engine; and 3) he was disclosed as a fact witness during discovery. None of

these stated grounds can excuse Opposers' failure to disclose Mr. Whitmore as an unretained expert witness under Federal Rule of Civil Procedure 26(a)(2).

Mr. Whitmore's testimony regarding the functionality of GX engine components, third-party engines, and horizontal shaft engines ***in general*** constitutes opinion testimony under Federal Rule of Evidence 702 because it is based on scientific, technical, and specialized knowledge. Opposers were therefore required to disclose these opinions in accordance with Rule 26(a)(2) and the deadlines for expert disclosure set forth in the Scheduling Order. The fact that Honda deposed Mr. Whitmore as a fact witness and subsequently cross-examined him during Opposers' trial period (under protest) does not excuse Opposers' failure to disclose him as an unretained expert witness.

Finally, Opposers' argument that Honda elicited mirror image testimony from its own fact witness, Mr. Motohiro Fujita, is without merit. Unlike the testimony offered by Mr. Whitmore, Mr. Fujita's testimony was limited to factual statements based on his actual experiences designing the GX Engine that is the subject of this Opposition.

Accordingly, the Board should grant Honda's Motion to Strike the opinion portions of Mr. Whitmore's trial testimony.

II. Argument

A. Mr. Whitmore's Experience As A Briggs Employee Does Not Exempt Him From Rule 26's Expert Disclosure Requirements

Opposers' argument that Mr. Whitmore's opinions qualify as permissible lay testimony because they were developed while Mr. Whitmore worked for Briggs is misplaced. The distinction between permissible lay and opinion testimony that must be disclosed pursuant to Rule 26 is not whether the opinions were developed during the course of employment, but rather whether the opinions are based on "scientific, technical, or other specialized knowledge." Fed.

R. Evid. 701. Opposers admit that Mr. Whitmore's opinions are based on "17 years of personal experience as a Briggs engineer" (Opp. at 1). Mr. Whitmore's opinions, based on his years of experience and training as a mechanical engineer, are exactly the type of scientific, technical, and specialized knowledge that Rule 701 contemplates. *Crest Res., Inc. v. Dan Blocker Petroleum Consultants, Inc.*, No. 09-CV-766-TCK-PJC, 2014 WL 1096366, at *7 (N.D. Okla. Mar. 19, 2014) (holding that a witness could not offer expert testimony "based upon scientific and specialized knowledge [he] acquired by virtue of his engineering expertise[,]" where the witness was not disclosed as an expert pursuant to Rule 26(a)(2)).

Opposers' assertion that Honda's motion should be denied because Mr. Whitmore's testimony was all based on his "personal experience" likewise misses the mark. Rule 26(a)(2)(C) specifically deals with the circumstance of an employee of a party who develops expert opinions during the course of his employment, rather than solely for the purpose of litigation. Pursuant to Rule 26(a)(2)(C), such unretained experts must disclose: 1) the subject matter on which they expect to present evidence; and 2) a summary of the facts and opinions to which they expect to testify. Fed. R. Civ. P. 26(a)(2)(C). Opposers clearly recognized the applicability of this Rule to this proceeding when they properly disclosed *other* employee experts pursuant to Rule 26(a)(2)(C) (*see* Dkt. 129, Declaration of Shira Hoffman in Support of Honda's Motion to Strike ("Hoffman Decl."), at Ex. B (Opposers' Joint Disclosure of Rebuttal Expert Witnesses)). Indeed, there is no difference in the circumstances relating to Mr. Peter Hotz – one of the individuals disclosed as an unretained expert – and Mr. Whitmore. Both Mr. Hotz and Mr. Whitmore are engineers who have worked at Briggs for many years; both were involved in the development of the Briggs 550 Series engine; and both were disclosed as fact witnesses during discovery. (*See* Declaration of Silena Paik in Support of Honda's Reply ("Paik Decl."), Ex. A at

42:25-50:25; 187:1-24 (Hotz Discovery Depo. Tr.); Paik Decl., Ex. B at 4 (Briggs' Responses to Honda's First Set of Interrogatories).) Yet, Opposers' brief provides no explanation for their decision to disclose Mr. Hotz as a potential expert but not Mr. Whitmore.

Opposers cite a handful of cases for the proposition that "courts across the country routinely allow lay opinion testimony based on the knowledge gained from the witness's employment experience." (Opp. at 8.) The majority of these cases, however, were decided ***before*** the 2010 amendments to Rule 26, which for the first time imposed disclosure requirements on unretained experts.[1] *See, e.g.*, *United States v. Munoz-Franco*, 487 F.3d 25 (1st Cir. 2007); *Tampa Bay Shipbuilding & Repair Co. v. Cedar Shipping Co.*, 320 F.3d 1213 (11th Cir. 2003); *Medforms, Inc. v. Healthcare Management Solutions, Inc.*, 290 F.3d 98 (2d Cir. 2002); *Union Pacific Resources Co. v. Chesapeake Energy Corp.*, 236 F.3d 684 (Fed. Cir. 2001).[2] In the remaining cases, the employee witnesses gave limited testimony relating specifically to the products of their employers, and were not permitted to give opinion testimony going to the ultimate issue in the case. *Open Text S.A. v. Box, Inc.*, No. 13-cv-04910-JD, 2015 U.S. Dist. LEXIS 11318, at *24 (N.D. Cal. Jan. 29, 2015) (expert witnesses developed alternative designs, and lay witness was not permitted to testify to ultimate issues); *Carnegie Mellon Univ. v. Marvell Tech. Group, Ltd.*, No. 09-290, 2013 U.S. Dist. LEXIS 58331, at *11-12 (W.D. Pa. April 24, 2013) (witnesses did not offer testimony regarding third-party products); *In re Google AdWords Litig.*, No. 08-cv-3369 EJD, 2012 U.S. Dist. LEXIS 1216, at *18 (N.D. Cal.

[1] Prior to the 2010 amendments, parties were only required to disclose the identity of any witness planning to offer testimony under FRE 702. The new Rule 26(a)(2)(C) mandated counsel-prepared disclosures for un-retained experts, for the first time identifying the subject matter and scope of those opinions.

[2] Opposers cite *Pepsico, Inc. v. Pirincci*, Opp. 91187023, 2014 WL 1679144, at *24, n.30 (T.T.A.B. 2014), for the proposition that the Board admits "lay opinion testimony based on knowledge and experience gained during employment." (Opp. at 9.) However, in the footnote Opposers cite, the Board states clearly that the lay witness's testimony was "not based on specialized knowledge such as that only an expert in the field might possess." *Id.* (citing Fed. R. Evid. 701). A prior decision in the same matter offers better guidance on the Board's practices with regard to insufficient expert disclosures. *See Pepsico, Inc. v. Pirincci*, Opp. 91187023, 2013 WL 8456132, at *2 (T.T.A.B. 2013) ("To the extent that any of the . . . [w]itnesses are intended to serve as expert witnesses, opposer's motion is well-taken. As opposer points out, none of the . . . [w]itnesses were identified in applicant's expert disclosures . . . .").

Jan. 5, 2012) (witness did not offer opinions regarding third-party products or the industry generally, and was not permitted to "opine[] on the merits of the case"). Furthermore, the scope and subject matter of the opinions at issue in these cases were disclosed prior to trial. *Open Text*, 2015 U.S. Dist. LEXIS 11318, at *3 (seeking pretrial motions to exclude); *Carnegie Mellon*, 2013 U.S. Dist. LEXIS 58331, at *4 (seeking to strike pretrial affidavits); *In re Google*, 2012 U.S. Dist. LEXIS 1216, at *9-10 (seeking to strike pretrial declarations). The opposing parties therefore had notice of the opinions and an opportunity to prepare to cross examine the witnesses on them; they were not ambushed with the witnesses' opinions for the first time at trial, as was the case here. *See id.* Finally, the fact that Opposers recognized the obligation to disclose precisely the type of lay opinion testimony that they elicited from Mr. Whitmore for other witnesses undermines their attempt now to claim that they had no such disclosure obligation.

B. Honda Seeks Only To Strike Improper Opinion Testimony

Contrary to Opposers' assertions, Honda does not seek to strike proper lay testimony about Mr. Whitmore's experiences developing the Briggs & Stratton 550 Series engine. In an effort to characterize the testimony Honda seeks to strike as proper lay testimony, Opposers point to other, unrelated testimony where Mr. Whitmore discusses his actual work on the Briggs 550 Series engine – ***testimony that Honda does not seek to strike***. (*See, e.g.*, Opp. at 12 (citing testimony regarding Briggs' typical design requirements); 12-13 (citing testimony regarding attempts to fit prototype Briggs 550 Series engine into applications).) Opposers admit, however, that before the testimony regarding his actual work on the 550 Series engine, Mr. Whitmore testified regarding his opinion as to the "essential function" of the component parts of the Honda GX Engine (which he did not develop), "typical configuration," and "design considerations for this type of engine." (*See, e.g.*, Opp. at 5-6.) These statements plainly reflect opinions based on Mr. Whitmore's education and training, rather than lay testimony about experiences in which he

personally was involved. Opinion testimony regarding such subject matter without proper disclosure is improper and should be stricken.

Opposers maintain that this opinion testimony is based on Mr. Whitmore's knowledge of "the horizontal shaft engine industry." (Opp. at 4, 6.) However, the issue is not whether Mr. Whitmore was qualified to give the opinions that he offered. Rather, the issue is whether the testimony he seeks to offer about the GX engine, third party engines, or the industry in general constitutes opinion testimony that Opposers were required to disclose. During his trial testimony, Mr. Whitmore opined on the functionality of the GX Engine's features and third party engines, and offered ***general*** opinions about the functionality of horizontal shaft engine components. This testimony clearly extended beyond the scope of Mr. Whitmore's actual experience designing the Briggs 550 Series engine and into the realm of expert testimony. Indeed, Opposers solicited expert opinion testimony on precisely these topics from a third party retained for the purpose of providing expert opinion regarding the alleged functionality of the applied-for mark. (*See* Paik Decl., Ex. C at 4 (Opposers' Pretrial Disclosures); Paik Decl., Ex. D at 6:11-18; 25:25-26:10. (Reisel Trial Tr.)) The following example is illustrative:

> **Q**: "What's the functional benefit of having those levers recessed?
>
> **A**: "The functional benefit of having them recessed, one, is to minimize the length of the levers. Having them shorter makes them stronger. Those are critical functions of the engine. Additionally, having them recessed back into the engine allows them to be protected from the environment, so from impacts that might happen to them, you know." (Dkt. 129, Hoffman Decl., Ex. A at 47:22-48:7 (Whitmore Trial Tr.).)
>
> **Q**: "[D]o you have an opinion with respect to the recessed area that's part of the trademark . . . ?
>
> **A**: "Yes. Having the control levers in a recessed area . . . should increase their durability or at least it gives them the potential to increase their durability and, therefore, make the engine more desirable to the customer. By being recessed, these levers are not protruding out from the engine as much as they otherwise

> would have to be if they were mounted onto a flat surface . . . . That is going to reduce the potential of something brushing up against it, breaking off the lever, changing the position of the lever in an undesirable fashion." (Paik Decl., Ex. D at 53:1-15 (Reisel Trial Tr.))

Opposers cannot argue that these same opinions coming from Mr. Whitmore constitute permissible lay testimony simply because he is employed by Briggs.[3]

C. Opposers' Failure To Disclose Mr. Whitmore As An Expert Was Not Harmless

Mr. Whitmore's disclosure as a potential ***fact*** witness during discovery does not render his sudden transformation into an expert witness harmless.[4] The purpose of Rule 26's expert disclosure requirements is to inform the opposing party of both the intent of a witness to offer expert opinions and the scope of those opinions ahead of time. Indeed, "[t]he absence of any required disclosures . . . len[ds] itself to the prospect of trial by ambush," which is exactly what happened here. Gregory P. Joseph, *2010 Expert Witness Rule Amendments*, ABA Section of Litigation: Trial Evidence (April 28, 2011), available at https://apps.americanbar.org/litigation/committees/trialevidence/articles/042811-expert-witness-rule-amendments.html.

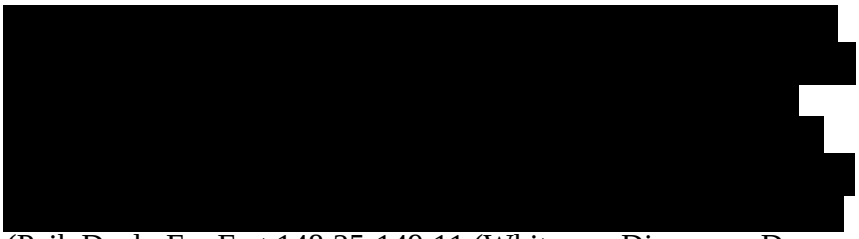
Furthermore, the fact that Honda deposed Mr. Whitmore during the fact discovery phase of this proceeding does not mitigate the prejudice to Honda from Opposers' surprise questioning of Mr. Whitmore as an expert during his trial deposition. Deposing an individual as a pure fact witness may involve wholly different strategic considerations and preparation from deposing that same individual as an expert. *See* Fed. R. Civ. P. 26(a)(2), Advisory Committee Notes ("Effective cross-examination of an expert witness requires advance preparation. The lawyer

[3] While in this particular example Mr. Reisel's testimony is consistent with Mr. Whitmore's, in many cases, Mr. Whitmore has offered testimony that differs from (and is more favorable to Opposers than) Mr. Reisel's testimony on the same issues. (*See* Opening Br. at 7.)

[4] Similarly, it is irrelevant that Honda identified Mr. Whitmore as a potentially relevant *fact* witness in its initial disclosures.

even with the help of his own experts frequently cannot anticipate the particular approach his adversary's expert will take or the data on which he will base his judgment on the stand.").

On account of Opposers' failure to disclose their intent to elicit opinion testimony from Mr. Whitmore and the subject matter and scope of such testimony, Honda did not have the opportunity during Mr. Whitmore's deposition to explore these opinions and their basis, or to prepare to confront these opinions during his cross-examination. And contrary to Opposers' assertions, Mr. Whitmore offered many opinions at trial to which he did not testify during his discovery deposition. For example, during Mr. Whitmore's discovery deposition, Honda asked him whether Briggs had considered any alternative designs with respect to the Briggs 550's controls, subject matter that was within his personal experience, and he responded:



(Paik Decl., Ex. E at 148:25-149:11 (Whitmore Discovery Depo. Tr.).)

By contrast, at trial Mr. Whitmore opined at length about the functionality of controls ***in general***:

> **Q**: Let's talk about the two control levers we've been discussing, the choke and the fuel levers. Would there be any functional disadvantage to moving the location of those levers?
>
> **A**: With the location of the choke and the fuel valve fixed, if those levers were to move, you would essentially be creating a longer, more complicated mechanism that would need to transfer the human motion of moving the lever and transfer that motion back to the location it needs to act upon. So you would end up with more complex systems that would be more costly. And any system in any complex system just has greater likelihood of failure as compared to a more simple system. So we would potentially see increased warranty or customer dissatisfaction.
>
> **Q**: Would that affect the manufacturing cost for those parts, too?

A: Yes. Any additional parts require—any additional parts require additional labor in order to assemble it and put it on the engine. So that would increase manufacturing costs.

Q: Would there be any functional disadvantage to having the controls no longer be recessed?

A: The functional disadvantage there I had referenced in a previous answer. Having them stick out farther creates longer levers that are potentially weaker. It puts the levers in the position where they're more prone to be impacted either by something falling or by being run into something which could potentially damage them and create failures. (Dkt. 129, Hoffman Decl., Ex. A at 52:14-54:2 (Whitmore Trial Tr.).)

Had Honda been on notice of the subject matter and scope of the opinions that Mr. Whitmore expected to give, it would have probed further into Mr. Whitmore's opinions about the purported functionality of various aspects of the appearance of horizontal shaft engines generally or the GX engine in particular, and could have prepared to confront Mr. Whitmore about these opinions at trial.

The fact that Honda had an opportunity to cross-examine Mr. Whitmore during Opposers' trial period is likewise irrelevant to whether Mr. Whitmore's undisclosed opinion testimony was proper. Where a party did not have adequate notice of the subject matter and scope of a witness's intended opinion testimony, having an opportunity to depose or cross-examine the individual does nothing to alleviate the prejudice to that party. *See LaShip, LLC v. Hayward Baker, Inc.*, 296 F.R.D. 475, 484-485 (E.D. La. 2013) (testimony of expert whose Rule 26(a)(2)(C) disclosures were incomplete was excluded even though expert was deposed and subject to cross-examination at trial); *Rothberg v. Cincinnati Ins. Co.*, No. 1:06-CV-111, 2008 WL 5545468, at *4 (E.D. Tenn. May 7, 2008) (holding that where an expert failed to comply with the requirements of Rule 26(a)(2), the expert's deposition did not afford a party the opportunity to conduct adequate cross-examination).

D. Honda Did Not Open The Door To Improper Expert Testimony During Its Cross-Examination

The fact that Honda cross-examined Mr. Whitmore at trial (under protest and after reserving its right to move to strike the objectionable testimony) does not justify admitting his improper expert opinions into the record. The Board has clearly articulated rules that govern trial objections based on the failure to properly disclose expert witnesses. *See* TBMP § 533.02-533.03. Pursuant to 37 C.F.R. § 2.123(e)(3), "[i]f pretrial disclosures . . . are improper or inadequate with respect to any witness, an adverse party may cross examine that witness under protest while reserving the right to object to the receipt of testimony in evidence." The record reflects that Honda timely objected and conducted its cross examination under protest. (Dkt. 129, Hoffman Decl., Ex. A at 92:10-22.) Because Mr. Whitmore testified as if he were an expert witness, Honda was forced to conduct his cross-examination accordingly. Thus, Honda's cross-examination under protest should not serve as a basis for admitting Mr. Whitmore's improper expert opinions into the record.

E. Honda's Fact Witness Did Not Provide "Mirror Image" Testimony

Unlike Mr. Whitmore, Honda did not elicit, and Honda's fact witness, Mr. Fujita, did not offer improper expert opinions during his trial deposition. Viewing the testimony of Mr. Fujita to which Opposers point in context, it is clear that Mr. Fujita testified regarding his actual experience designing the Honda GX Engine. Mr. Fujita was never asked about, and did not offer any opinions on the horizontal shaft engine industry in general, or engines manufactured by Opposers or any other third parties.[5]

[5] In any event, to the extent Opposers believe Mr. Fujita's testimony constituted improper expert opinion, they should have raised their objections at the time of his deposition or promptly thereafter, in accordance with Board procedures. *See* 37 C.F.R. § 2.123(e)(3) (providing that "[p]romptly after the testimony is completed, the adverse party, to preserve the objection, shall move to strike the testimony from the record . . . ."). Mr. Fujita's testimony deposition took place in December of 2014. Opposers did not object then, or at any time prior to the filing of Honda's Motion to Strike, to what they now identify as "improper" testimony from Mr. Fujita. Thus, Opposers' untimely request to strike portions of Mr. Fujita's testimony should be denied.

III. Conclusion

For the foregoing reasons, Honda respectfully requests that the Board grant its Motion to Strike the Improper Expert Testimony of Fact Witness Jeff Whitmore.

Respectfully submitted,

Dated: August 26, 2015

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Reply in Support of Applicant's Motion to Strike Improper Expert Testimony of Fact Witness Jeff Whitmore was served by FedEx this 26th day of August, 2015 upon:

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